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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

First Named Applicant: Rillie

Serial No.: 09/376,461

Filed: August 18, 1999

For: SKYLIGHT FLASHING



) Art Unit: 3634

) Examiner: Cohen

) **1128.006A**

) November 28, 2000  
750 B STREET, Suite 3120  
San Diego, CA 92101

APPEAL BRIEF

Commissioner of Patents and Trademarks  
Washington, DC 20231

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Dear Sir:

TO 3600 MAIL ROOM

This brief is further to the Office Action dated October 10, 2000 and is submitted under 35 U.S.C. §134. This appeal is further to Appellant's Notice of Appeal filed herewith.

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**(1) Real Party in Interest**

The real party in interest is the assignee.

**(2) Related Appeals/Interferences**

No other appeals or interferences exist which relate to the present application or appeal.

**(3) Status of Claims**

Claims 1-4 and 6-9 are pending and elected. Claims 10-15 are non-elected claims. All pending elected claims have been finally rejected, and the rejections of the claims are hereby appealed. A copy of the claims is enclosed herewith as Appendix A.

**(4) Status of Amendments**

An amendment canceling Claim 5 has been submitted, and the examiner has indicated that it will be entered upon filing this brief. Accordingly, for purposes of this appeal it will be assumed that the only claims at issue are 1-4 and 6-9.

**(5) Summary of Invention**

The invention is a seamless metal flashing for a roof-mounted skylight, as set forth in Claim 1. As set forth in Claim 6, it includes a hollow frusto-conical shaped curb defining a bottom end, and a metal skirt extending radially away from the bottom end. The skirt is formed with at least one surface strengthening anomaly, such as a rib.

**(6) Issues**

- (a) Whether Claim 1 is unpatentable under 35 U.S.C. §102(e) as being anticipated by Chao (assignee's own previous patent).
- (b) Whether Claim 1 is unpatentable under 35 U.S.C. §103 as being obvious over DeBlock et al. in view of Hoy et al. and Strieter.
- (c) Whether Claim 6 is unpatentable under 35 U.S.C. §102(e) as being anticipated by Chao (assignee's own previous patent).
- (d) Whether Claim 6 is unpatentable under 35 U.S.C. §103 as being obvious over DeBlock et al. in view of Hoy et al., Strieter, and Blackmon et al.

**(7) Grouping of Claims**

Claims 1-4 stand together and apart from Claims 6-9. This is because the examiner has chosen a different combination of references to reject Claim 6 for obviousness than those used to reject Claim 1, and also because Claim 6 recites an element - the surface strengthening anomaly - not recited in Claim 1. Therefore, Claim 6 is potentially separately patentable from Claim 1.

**(8) Argument**

- (a) Claim 1 has been finally rejected under 35 U.S.C. §102(e) as being anticipated by the present assignee's own Chao patent. The Chao flashing, however, is not seamless, as required by Claim 1. Not only does Applicant know this since he is the CEO of the company that owns the Chao patent and is also a co-inventor thereof, but it is also shown in Figure 1, wherein lines extend from the top ring of the flashing curb

22b down to the flange 22a, particularly on the right side of the curb near the notch in the top ring. For some reason, the examiner persists in characterizing the Chao patent as showing a seamless flashing. Regardless, since Chao clearly shows seams, the rejection of Claim 1 based on Chao should be reversed.

(b) Claim 6 has been finally rejected under 35 U.S.C. §102(e) as being anticipated by Chao. The Chao flashing, however, does not have the claimed surface strengthening anomaly. The examiner simply alleges otherwise without pointing to structure by reference numeral or specification citation. Is the examiner perhaps confusing what are obviously surface shading lines on the flange 22a with the claimed element? These lines quite clearly are an artifact of Patent Office surface shading requirements, not structure. Certainly, nothing in the comprehensive specification of Chao mentions surface strengthening anomalies. In any case, conjuring something up from a prior art patent out of thin air to reject a claim clearly does not pass muster under the MPEP, and the present rejection should be reversed.

(c) Claim 1 has been rejected under 35 U.S.C. §103 as being obvious over DeBlock et al. in view of Hoy et al. and Strieter. DeBlock has been used as a teaching of a skylight flashing, while Hoy et al., which teaches a plastic curb, has been used as a teaching of a seamless feature. Strieter has been used as a teaching of a metal flashing.

The problem with this proposed combination of structure is that it does not comply with the requirements of MPEP §2142 in making a *prima facie* case of obviousness, in that no expectation of success has been shown in combining the references nor can it be. That was precisely the point of Applicant's previous argument, which the Examiner has discounted, namely, that the way the plastic cover of Hoy et al.

is made - by vacuum forming - would militate against combining Hoy et al. with a metal flashing reference, because metal flashings cannot be formed by vacuum forming, to the best of Applicant's knowledge. Thus, far from arguing a method of manufacture in an attempt to patent a device claim, the present argument instead is directed to showing why no reasonable expectation of success exists in combining the references as proposed by the Examiner, thus demonstrating why a *prima facie* case of obviousness has not been properly made.

Furthermore, the Examiner has stated that "it is the Examiner's position that the process of stamping a seamless metal member is a well-known expedient in the art." Applicant, who for many years has been the CEO of a leading manufacturer of skylights in the United States, is under no such misconception. "Examiner positions" are not allowed to substitute for prior art evidence. Accordingly, the failure by the examiner to produce a prior art showing supporting the examiner's position that stamping a seamless metal member is a well-known expedient in the art of skylight flashing manufacture, which showing was previously requested under MPEP §2144.03, further militates against sustaining the present rejection.

(d) Claim 6 has been rejected under 35 U.S.C. §103 as being obvious over DeBlock et al. in view of Hoy et al., Strieter, and Blackmon et al., used as a teaching of ribs. Blackmon et al. teaches a reflector for a spaceship-borne solar power generator. It accordingly is non-analogous art to the skylight field. That is, Applicant believes that the spaceship-borne solar power art would not have been so pertinent to the problems sought to be solved by the present skylight flashing that it would have reasonably commended itself to the attention of one skilled in the skylight art, as otherwise required by MPEP §2141.01(a). For this reason, the obviousness rejection of Claim 6 should be reversed.

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1. A tubular skylight comprising:  
a seamless metal flashing;  
a transparent dome engageable with the flashing; and  
at least one skylight tube depending downwardly from the flashing.
2. The skylight of Claim 1, wherein the flashing comprises:  
a hollow frusto-conical shaped curb defining an open top, the open top being covered by the dome, the curb defining a bottom opposite the open top; and  
a skirt extending radially away from the bottom of the curb, the skirt being formed with at least one rib.
3. The skylight of Claim 2, wherein the skirt defines a radial dimension, and the skirt is formed with plural ribs, each rib being oriented radially on the skirt.
4. The skylight of Claim 2, wherein the skirt defines an outer periphery, and the rib is formed along at least part of the periphery.
6. A roof flashing, comprising:  
a hollow frusto-conical shaped curb defining a bottom end; and  
a metal skirt extending radially away from the bottom end, the skirt being formed with at least one surface strengthening anomaly.
7. The roof flashing of Claim 6, wherein the surface strengthening anomaly is a rib, the skirt defines a radial dimension, and the skirt is formed with plural ribs, each rib being oriented radially on the skirt.
8. The roof flashing of Claim 6, wherein the surface strengthening anomaly is a rib, the skirt defines an outer periphery, and the rib is formed along at least part of the periphery.
9. The roof flashing of Claim 7, wherein the skirt defines an outer periphery, and the flashing includes at least one rib formed along at least part of the periphery.